REMARKS:

In the outstanding Office Action, the Examiner rejected claims 1-15. No new matter is presented. Thus, claims 1-15 are pending and under consideration. The rejections are traversed below.

REJECTION UNDER 35 U.S.C. § 102(b):

Claims 1-4 and 7-15 were rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 5,855,008 (Goldhaber).

Goldhaber is directed to attention brokerage using cybercoins and coupons as an incentive to obtain attention of consumers. The Examiner refers to Fig. 11 and col. 18, lines 16-35 as teaching the claimed invention. However, Goldhaber describes a coupon displayed on a screen using a consumer's software agent where a cybercoin, a consumer interface button, is provided next to each title of a list (see, col. 5, lines 30-41). In reference to coupons, Goldhaber explicitly states, "A coupon 63 bypasses the profile matching process described above, by allowing the consumer to directly express a desire to receive information about a certain product or service" (see, col. 18, lines 20-23). Further, Goldhaber states, "if the consumer 'clips' a coupon directed to non-fat desserts, the consumer's software agent 110 will automatically search for ads that are associated with that coupon and retrieve thumbnail descriptions of all such ads" (see, col. 18, lines 23-27) and "The consumer may view the associated ad by simply clicking on the coupon icon 63" (col. 18, lines 34-36).

As can be seen from the above discussion, the Goldhaber system is limited to causing an associated advertisement to be presented to a consumer when the consumer's action regarding a coupon indicates the consumer's desire to be presented with the advertisement.

As further shown in Fig. 3 of Goldhaber, the consumer uses a computer to read or interact with information evidencing that the customer has paid attention, in response to which the information provider compensates the consumer by providing a payment in the form of digital cash and/or a credit on the consumer's account (see, col. 10, lines 49-57).

In contrast to Goldhaber, the claimed invention stores the coupon information pertaining to an advertisement in response to transmitting the advertisement to a requesting terminal.

Independent claim 1, by way of example, recites "transmitting said advertisement information to a terminal... and, as an immediate consequence of said transmitting, storing said coupon information associated with said advertisement information transmitted to said terminal,

in association with said terminal" (emphasis added). Claim 1 further recites, "referring to said coupon information stored in association with said terminal and determining a benefit upon purchase of the given commodity in response to a benefit inquiry request for said given commodity from said terminal." Independent claims 12, 14 and 15 also recite similar features.

Independent claims 11 recites, "transmitting said advertisement information to a terminal... as an immediate consequence of said transmitting, storing said coupon information associated with said advertisement information transmitted to said terminal, in association with said terminal." Claim 11 further recites, "referring to said coupon information stored in association with said terminal" for determining "a price upon purchase of the given commodity in response to an application for the purchase of the given commodity from said terminal" and "producing a sales contract for the given commodity with the determined price applied, and settling the purchase of the given commodity based on the sales contract."

Independent claim 13 recites, "acquiring first contents to which advertisement information is related" and "transmitting said first contents and said advertisement information to the terminal in response to a request from said terminal and, as an immediate consequence of said transmitting, storing first coupon information associated with said advertisement information transmitted to said terminal, in association with said terminal." Claim 13 further recites, "acquiring second contents including a list of commodities to which types of second coupon information defining a benefit upon the purchase of the commodities are related" and "transmitting said types of second coupon information related to the list of commodities included in said second contents and said identifier to said coupon management server to acquire usable coupon information from said coupon management server."

Goldhaber does not teach or suggest each and every feature of the independent claims including "transmitting advertisement information to a terminal [and] as an immediate consequence of said transmitting, storing said coupon informatics, associated with said advertisement information transmitted to said terminal, in association with said terminal", as recited in independent claims 1 and 11-15 ("first" and "second" contents in claim 13).

It is submitted that the independent claims are patentable over Goldhaber.

For at least the above-mentioned reasons, claims depending from the independent claims are patentably distinguishable over Goldhaber. The dependent claims are also independently patentable. For example, as recited in claim 9, "said coupon information represents a condition in which said benefit is applicable, and the benefit defined by said coupon

7

information is applied to the sales contract only when said condition is satisfied upon the purchase of the given commodity."

Goldhaber does not teach or suggest storing coupon information responsive to transmission of a corresponding advertisement where the coupon information represents "a condition in which said benefit is applicable, and the benefit defined by said coupon information is applied to the sales contract only when said condition is satisfied upon the purchase of the given commodity", as recited in claim 9.

Therefore, withdrawal of the rejection is respectfully requested.

REJECTION UNDER 35 U.S.C. § 103(a):

Claims 5 and 6 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Goldhaber and U.S. Patent No. 5,970,469 (Scroggie).

The Examiner acknowledges that Goldhaber fails to teach that the coupon information represents an expiry date and can be used only prior to the expiry date, but relies on Scroggie as teaching the same. However, Scroggie is limited to delivering purchasing incentives and shopping aids for selection by a customer. For example, as shown in Fig. 5 of Scroggie, advertised offers submitted by product manufacturers are provided to the customers, from which the customers may select prior or next offers or a coupon based on the offer (see, col. 7, line 53-61). Only then, is the coupon and the information to be incorporated is input (see, col. 10, lines 21-30).

Scroggie, similar to Goldhaber, is limited to generating an incentive based on designation by the customer.

In contrast, the claimed invention of claims 5 and 6 is directed to maintaining coupon information responsive to transmission of the advertisement where the coupon information represents "an expiry date" (Claim 5) and "a period after which a user is able to use a coupon actually after the user has acquired the coupon" (Claim 6). Scroggie and Goldhaber do not teach or suggest these features of claims 5 and 6.

Therefore, withdrawal of the rejection is respectfully requested.

WITHDRAWAL OF THE FINALITY OF THE OFFICE ACTION:

In light of the above, it is respectfully submitted that Scroggie and Goldhaber, alone or in combination, do not teach or suggest the claimed invention.

Thus, Applicants respectfully request reconsideration of the finality of the Office Action.

CONCLUSION:

There being no further outstanding objections or rejections, it is submitted that the application is in condition for allowance. An early action to that effect is courteously solicited.
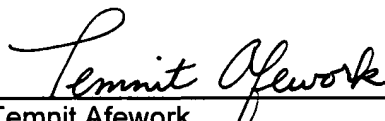
If there are any formal matters remaining after this response, the Examiner is requested to telephone the undersigned to attend to these matters.

If there are any additional fees associated with filing of this Amendment, please charge the same to our Deposit Account No. 19-3935.

Respectfully submitted,

STAAS & HALSEY LLP

Date: 10/31/2006

By: _Temnit Afework_
Temnit Afework
Registration No. 58,202

1201 New York Ave, N.W., 7th Floor
Washington, D.C. 20005
Telephone: (202) 434-1500
Facsimile: (202) 434-1501